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In re Application
Fride et al.
Application No. 09/698,071
Filed: October 30, 2000
Atty Docket No. 7754-071

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: DECISION ON APPLICATION
: FOR PATENT TERM ADJUSTMENT
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This is a decision on the "PETITION FOR PATENT TERM ADJUSTMENT UNDER 37 C.F.R. § 1.705," filed September 22, 2004. Applicants request that the initial determination of patent term adjustment under 35 U.S.C. 154(b) be corrected from two hundred forty-five (245) days to two hundred fifty-six (256) days.

The application for patent term adjustment is **GRANTED** to the extent indicated herein.

The Office has updated the PAIR screen to reflect that the correct Patent Term Adjustment (PTA) determination at the time of the mailing of the Notice of Allowance is two hundred twenty-six (226) days. A copy of the updated PAIR screen, showing the correct determination, is enclosed.

On June 29, 2004, the Office mailed the Determination of Patent Term Adjustment under 35 U.S.C. 154(b) in the above-identified application. The Notice stated that the patent term adjustment (PTA) to date is 245 days. On September 22, 2004, applicants timely¹ submitted an application for patent term adjustment (with required fee). Applicants dispute the reduction of 11 days attributed to applicant for failing to respond within three months to the Notice to File Missing Parts of Application mailed December 29, 2000.

Applicants specifically state that the patent issuing from the application is not subject to a terminal disclaimer.

The reduction of 11 days has been found to be incorrect. A review of the application file reveals that applicants' response to the Notice to File Missing Parts of Application mailed December 29, 2000, is of record in the application with a date of receipt by the Office of January 5, 2001. Furthermore, the response included a complete reply to the Notice. Thus, the Office should not have assessed applicants a delay of 11 days.

¹ The Issue Fee payment was also received in the Office on September 22, 2004.

The response was filed within the three-month period under 37 CFR 1.704(b) and accordingly, applicants' delay should have been assessed as zero (0) days. Applicants did not fail to engage in reasonable efforts to conclude prosecution of the application by delaying in replying to the Notice to File Missing Parts of Application.

However, a review of the application history has revealed that applicants failed to engage in reasonable efforts to conclude prosecution by filing a supplemental paper on May 13, 2004. As set forth at 37 CFR 1.704(c)(8), circumstances that constitute a failure of the applicant to engage in reasonable efforts to conclude processing or examination of an application include:

Submission of a supplemental reply or other paper, other than a supplemental reply or other paper expressly requested by the examiner, after a reply has been filed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the number of days, if any, beginning on the day after the date the initial reply was filed and ending on the date that the supplemental reply or other such paper was filed.

In this instance, applicants filed a request for continued examination on April 13, 2004, and then filed a further affidavit on May 13, 2004. The record does not support a conclusion that the additional reply to the final Office action was expressly requested by the examiner. Thus, the period of reduction is thirty (30) days, the number of days beginning on the day after the date the initial reply was filed, April 14, 2004 and ending on the date that the supplemental reply was filed, May 13, 2004.

In view thereof, the correct determination of patent term adjustment at the time of the mailing of the Notice of Allowance is two hundred twenty-six (226) days.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application file is being forwarded to the Office of Patent Publication for issuance of the patent.

Telephone inquiries specific to this matter should be directed to Nancy Johnson, Senior Petitions Attorney, at (571) 272-3219.

Karin A. Ferriter

Karin Ferriter
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
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Enclosure: Copy of Revised PAIR Screen